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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/591,547

07/06/2007

Ruth Iaconi-Forrer

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WOODCOCK WASHBURN LLP  
CIRA CENTRE, 12TH FLOOR  
2929 ARCH STREET  
PHILADELPHIA, PA 19104-2891

EXAMINER

GEHMAN, BRYON P

ART UNIT

PAPER NUMBER

3728

MAIL DATE

DELIVERY MODE

05/05/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/591,547	<b>Applicant(s)</b> IACONI-FORRER ET AL.	
	<b>Examiner</b> Bryon P. Gehman	<b>Art Unit</b> 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 35-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 35-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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1. It is not clear that there is any submission of separate formal drawings of record in this application, as any drawings associated with this application are part of other submissions. While those submissions are sufficient for examination purposes, it is required that drawings be furnished in response to this action.

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

There are presently two claims 41.

Misnumbered claims 41(second) through 51 have been renumbered 42-52.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 43-45, 47 and 50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 42 and 43, "at least one leg" is indefinite as to its relation to the prior defined legs and should be --at least one said leg--.

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In claim 44, the allusion to an imaginary “rail of the carrier system” is indefinite and indeterminate from the actually claimed structure.

In claim 45, the relationship of “another container” to the previously defined “container” is indefinite. Are the same or merely arbitrary “containers”?

In claim 47, line 1, “the first carrier” lacks antecedent basis, as only one “first carrier” has not been distinguished. See also claims 48 and 49.

In claim 50, line 2, the definition “the surgical component extends into the channel” is indefinite whether such defines a positive definition of structure, or merely an inferred possibility, as “the surgical component: previously referred to is imaginary.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 35-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Kumar (6,561,805). Claims 35-36 and 43-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Frush et al. (6,382,575). Claims 35-36 and 40-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Vincze et al. (5,551,214). Claims 35 and 40-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Malec et al. (5,279,416). Claims 35, 37-39 and 43-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Reynolds (3,624,867). Each discloses a container (15; 10; 290; 10; 40; respectively)

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for retaining a surgical component, comprising a carrier (22; 14; 300; 40; 20) having a storage area (24; 40; 310; at 42; 24) for retaining a surgical component, and legs (portions between elements 26; adjacent 34; adjacent 312; on either side of 60; 26 and 26) for engaging a carrier system, and a removable cover (31; 12; 340; 12; 42) attached to the storage area of the carrier.

As to claim 36, Kumar, Frush et al. and Vincze et al. each disclose an upwardly-extending handle (33; 22; portion of 340 above 341).

As to claims 37-39, Kumar and Reynolds each disclose the storage area as a hole particularly shaped particularly to receive a screw. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Applicants are not positively claiming a bone screw per se, so its possible inclusion is considered, not its actual existence as an element of the claimed invention.

As to claims 40 and 41, Kumar, Vincze et al. and Malec et al. each disclose the cover having inwardly-extending elements (39; 344; 27) which may be characterized as teeth.

As to claim 42, Kumar, Vincze et al. and Malec et al. each disclose the legs extending transverse to a dimension of the storage area.

As to claim 43, the composition of a "runner" is undistinguished by the claim, and as much as defined a portion of each reference leg may be so characterized.

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As to claim 44, each discloses at least one leg able to engage a rail, while Frush et al. do disclose a leg (adjacent 34) engaging a rail (42 or 44).

As to claim 45, each is disclosed or capable of being placed adjacent another container.

7. Claims 46-50 and 52 are rejected under 35 U.S.C. 102(b) as being anticipated by Frush et al.. Claims 46-50 and 52 are rejected under 35 U.S.C. 102(b) as being anticipated by Vincze et al.. Claims 46-52 are rejected under 35 U.S.C. 102(b) as being anticipated by Reynolds Each discloses a carrier system comprising first and second rails (42 or 44; two portions of 30; opposed portions of 50 engaging under 22), first and second carriers (multiple elements 10; multiple elements 290; 20) disposed along the rails, individual removable covers (12; 340; portion of 42 atop an individual carrier 20), the carriers configured to retain a surgical component.

As to claim 47, each discloses a carrier having a leg (adjacent 34; 312; 26).

As to claims 48 and 49, each carrier is slid or slidable along the rails adjacent thereto and retained thereby.

As to claim 50, each discloses a channel (44; see Figure 5; carrying 20) disposed between the rails (42; see Figure 5; consider Figure 2a).

As to claim 51, the content is imaginary, and Reynolds may inherently carry a bone screw.

As to claim 52, each cover is independently removable from the other cover.

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8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fellingner and Faccioli et al. were cited in the corresponding PCT application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryon P. Gehman whose telephone number is (571) 272-4555. The examiner can normally be reached on Tuesday through Thursday from 7:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bryon P. Gehman/  
Primary Examiner, Art Unit 3728

Bryon P. Gehman  
Primary Examiner  
Art Unit 3728

BPG